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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/815,411 | 04/01/2004 | Marcus Braun | 04265293 | 7993 |

7590 10/05/2006

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EXAMINER

TOY, ALEX B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,411

Applicant(s)

BRAUN, MARCUS

Examiner

Alex B. Toy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/6/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 10, the language is so unclear that the examiner is unable to determine what the applicant intended to claim. The specification does not sufficiently define and describe "an axis of inclination of the instrument head". Appropriate correction is required.

Regarding claim 11, the language is unclear. It appears that the chamfering is aligned perpendicular to a direction of inclination of the instrument head in Figs. 6b-c and not in the same direction.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the language is unclear. The examiner assumes applicant intended to recite: "wherein the pushing rod and pushing pin are aligned coaxially to each other when the instrument head is inclined at 0 degrees with respect to the tube shaft." Appropriate correction is required.

Regarding claim 10, the language is so unclear that the examiner is unable to determine what the applicant intended to claim. What is the applicant defining as "an axis of inclination of the instrument head"? Appropriate correction is required.

Regarding claim 11, the language is unclear. It appears that the chamfering is aligned perpendicular to a direction of inclination of the instrument head in Figs. 6b-c and not in the same direction.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Zvenyatsky (U.S. Pat. No. 5,607,450).

Regarding claim 1, Zvenyatsky discloses a surgical instrument comprising an instrument handle 12 linked at a proximal end portion of a tube shaft 20 (Fig. 1), the tube shaft 20 having a distal end portion linked to an instrument head rotatably supporting an effector 30, 32 (Figs. 1 and 7), the effector 30, 32 being inclinable relative to the tube shaft 20 (Fig. 7), wherein the effector 30, 32 further comprises at least one pivotable engaging element 22 operable via an effector operating gear train 104, 110 in cooperation with the instrument handle (col. 5, ln. 19-50 and Figs. 3 and 7), wherein the effector operating gear train 104, 110 further comprises a pushing rod 78 shiftably arranged in the tube shaft 20 (Figs. 2 and 7), and in a linking area between the instrument head and the tube shaft the pushing rod 78 abuts a pushing pin 94 (Fig. 7), the pushing pin 94 being shiftably supported in the instrument head and/or the effector and operatively connected to the engaging element 22.

Allowable Subject Matter

Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding dependent claim 2, the prior art discloses numerous surgical instruments with pivoting heads such as the one of Zvenyatsky. Zvenyatsky and the prior art, however, do not disclose a pushing rod that is chamfered at a predetermined

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angle. Since the related devices including Zvenyatsky use pushing rods that are linked to the end effector with a hinge pin or are otherwise mechanically linked, there is no motivation to chamfer the distal end of Zvenyatsky's pushing rod.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| | | |
|-------------------|----------|---------------------------------|
| US 5174300 A | USPAT | Bales; Thomas O. et al. |
| US 5275608 A | USPAT | Forman; Jeffrey L. et al. |
| US 5330502 A | USPAT | Hassler; William L. et al. |
| US 5350391 A | USPAT | Iacovelli; Benedetto |
| US 5374277 A | USPAT | Hassler; William L. |
| US 5472451 A | USPAT | Freitas; Michael W. et al. |
| US 5474571 A | USPAT | Lang; Dieter |
| US 5545148 A | USPAT | Wurster; Helmut |
| US 5549637 A | USPAT | Crainich; Lawrence |
| US 5582617 A | USPAT | Klieman; Charles H. et al. |
| US 5603723 A | USPAT | Aranyi; Ernie et al. |
| US 5609601 A | USPAT | Kolesa; Michael S. et al. |
| US 5643294 A | USPAT | Tovey; H. Jonathan et al. |
| US 5702408 A | USPAT | Wales; Kenneth S. et al. |
| US 5743456 A | USPAT | Jones; Christopher Scott et al. |
| US 5827323 A | USPAT | Klieman; Charles H. et al. |
| US 5997565 A | USPAT | Inoue; Masahide |
| US 6068647 A | USPAT | Witt; David A. et al. |
| US 20020040217 A1 | US-PGPUB | Jinno, Makoto |
| US 20020055758 A1 | US-PGPUB | Sasaki, Katsumi |
| US 6666854 B1 | USPAT | Lange; Gregoire |
| US 6889116 B2 | USPAT | Jinno; Makoto |
| US 6936061 B2 | USPAT | Sasaki; Katsumi |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*
9/25/06

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER